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Docket NCR-11453

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REMARKS

Reconsideration of the above identified application is respectfully requested.

In response to the 7/24/06 office action, the undersigned attorney conducted a phone interview with the examiner on 10/05/06 to discuss the new rejections over the new reference Slagsvol along with previously overcome references Smith and Lane. No agreement was reached.

Accordingly, this amendment is being presented in a last effort to reach agreement and avoid the necessity of appeal. It is therefore requested that this amendment be given extra care and due weight to lead to the allowance of the claims as presently amended, or that the next office action be complete and that the search be finally thorough so that the Board can finally decide the patentability of the claims.

Firstly, Applicants note that the previous rejections over Lane and Smith have been fully overcome as acknowledged by the examiner in paras. 1 & 2.

Applicants traverse the new rejection of claim 31 under Section 102(b) over Slagsvol.

The examiner's contentions in para. 4 are not supported by this new reference, which the examiner has uncovered in a nonanalogous class.

A rejection under Section 102 is highly technical and mandates that identical elements in identical combination be found in a single embodiment in a single reference, and Slagsvol clearly fails this test.

The examiner's attempt to repeat in para. 4 features from Applicants' claim 31 in reference to Slagsvol is not supported by the express teachings thereof.

Fundamentally, claim 31 recites a label roll; which label rolls are notoriously well known products as evidenced by the references of record, including the separately applied reference

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Smith.

This is in stark contrast with Slagsvol which immediately states at col. 1, ll. 1+, that "This invention relates to the graphic arts, and more particularly, to tracing paper for use in duplicating graphic materials"

The various figures found in Slagsvol are express examples of such tracing paper with its transparent sheets for the express tracing function.

Accordingly, Slagsvol does not disclose any label or label roll, and the examiner has offered no evidence, including common dictionary definitions, that the tracing paper disclosed in Slagsvol is in fact configured as labels in any form.

Furthermore, the examiner references in para. 4 of the office action two different embodiments in Figures 2 or 6 of Slagsvol in the attempt to support the anticipation rejection. This is clear error, and is not permitted by Section 102.

Claim 31 recites a single column of the adhesive patches 38 along only one edge of the web; and the figure 2 embodiment of Slagsvol clearly shows two continuous adhesive strips 2b,c. Two does not anticipate one.

And, the figure 6 embodiment in Slagsvol is shown as a single sheet, which cannot anticipate the label roll with wound web as recited in claim 31.

Slagsvol is clear in its teachings of single sheets, pad, and roll form of the tracing paper, and differences therein, and associated problems. And, the examiner's attempt to disregard the boundaries and differences in those embodiments to support the anticipation rejection of claim 31 is unsupported by law, and erroneous on the facts.

Accordingly, withdrawal of the rejection of claim 31 under Section 102(b) over Slagsvol is warranted and is requested.

Applicants traverse the rejection of claims 1-9, 11-15, 17-25, and 27-29 under Section 103(a) over Smith and newly uncovered Slagsvol.

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Firstly, Slagsvol relates neither to Applicants' field of endeavor of adhesive labels, or to Applicants' many problems in the specialty labels used in the fast food industry, and is therefore nonanalogous art.

The field of endeavor in Slagsvol as indicated above from col. 1 of Slagsvol is tracing paper for graphic arts.

The problems in Slagsvol are presented at col. 1, ll. 11-25 and include time delays in taping tracing paper, and the loose fit thereof, along with undesirable tearing of the tracing paper; none of which are relevant to Applicants' problems.

The examiner may attempt to recharacterize the express field of endeavor and problems stated in Slagsvol in the belated attempt to force reference Slagsvol to apply, but this is not permitted by the MPEP and case law therein.

Since Slagsvol is nonanalogous art, it lacks requisite teachings to support any rejection of Applicants' claims; and therefore, the rejections under Section 103 are unwarranted and should be withdrawn.

The protracted history of this application is evidence of the inordinate attention to the various claims being made by the examiner, including repeated updates of the search. Rule 104 mandates thoroughness of examination and searching, and the examiner's latest update of the search is evidence of the lack of relevant references in the relevant art for use in rejecting the claims.

Not only is reference Slagsvol nonanalogous art, but the express disclosure thereof teaches away from the many claims now being rejected by the examiner.

It is clear that the examiner is applying Slagsvol not for its whole teachings, but for isolated features thereof in an attempt to fabricate new rejections of the claims using the previously applied reference Smith.

The lengthy para. 6 of the office action repeats substantially verbatim the examiner's previous contentions

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regarding Smith, and merely substitutes the new Slagsvol reference for the previous Lane reference overcome in the last traverse thereof.

In that last traverse, the many shortcomings and errors in the examiner's description of Smith were identified, and although that traverse was effective for overcoming the last rejection, the examiner has overlooked that traverse in fabricating the new rejection using the simple expedient of copying the previous remarks.

MPEP 707.07(f) mandates that the examiner answer the substance of Applicants' traverse, and in that regard the examiner has clearly admitted the inapplicability of Smith by the withdrawal of the previous rejections found in paras. 1 & 2 of the present office action.

In para. 8, the examiner merely contends that the previous arguments are "moot" in view of the new grounds, but the examiner overlooks that the "new" grounds copy in the entirety the previous grounds applying Smith.

The fundamental failure of Smith has now been expressly acknowledged by the examiner in withdrawing the previous rejections based thereon, and is now evidence of record against the new combination therewith of Slagsvol.

As previously indicated in the last amendment, and now being repeated herein, many of the examiner's contentions regarding Smith are unsupported by any evidence therein; and notwithstanding the second opportunity for the examiner to correct those contentions, the examiner has not.

Instead, the examiner continues to rely on the same, and erroneous, statements made in the previous office action, and now repeated in the latest office action.

It is now hoped that the examiner will devote extra attention to the present traverse in affording due weight to not only the express claim language, but the disparate references being applied.

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It is well recognized that label art is not only quite crowded, but has limited elements therein which necessarily must be repeated in drafting claims of correspondingly different scope to meet the patentability requirements of Sections 102 and 103.

Labels, webs, adhesive, release, die cuts, perforations, etc are notoriously well known in the label art, yet the present claims recite different and improved combinations of selected elements for a specific function and specific use not found in the references of record, including Slagsvol and Smith.

Most significantly, is the basic failure of Smith to disclose or suggest a plurality of discrete adhesive patches arranged in a column.

The adhesive is introduced at col. 3, line 56; and is applied in narrow strips 34,35 "preferably substantially continuous strips."

Although at col. 3, ll. 66+, Smith states that "other patterns can be applied ... or discontinuous depending upon the particular type of adhesive ...," there is no figure of such other patterns, no description thereof, and no teaching of any pattern relevant to the specific adhesive column's recited in Applicants' claims, or relevant to the disparate configuration of Lane.

Indeed, the examiner cites "Column 3, lines 42-46" which in turn describes "The patterns 27,28 ... illustrated in FIG. 3" of Smith for the "plurality of non continuous adhesive patches," but that figure 3 does not show the adhesive 34,35, but instead shows the silicone patterns 27,28.

This blatant error was brought to the examiner's attention in the third amendment, yet the examiner has failed to correct this error, which error wholly undermines the examiner's rejections.

Furthermore, the examiner admits the fundamental shortcoming of Smith which "fails to disclose the patches being

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aligned along one edge of said web and closer thereto than an opposite edge . . . , " along with other shortcomings.

Both independent claims 1 and 19 recite the single column configuration of the adhesive on the label roll for the many advantages disclosed in the specification.

In light of this fundamental shortcoming of Smith, the examiner has conducted another search, now into a nonanalogous US classification in an attempt to find naked elements without regard to context.

The newly uncovered reference Slagsvol teaches a disparate tracing paper, configured differently than the linerless labels disclosed in Smith, and used quite differently. The examiner has failed to establish any structural similarity with Smith to begin with, and then presents the conclusory statement of "for the purpose," which is not the legal motivation mandated by the MPEP ch. 2100, nor based on evidence, nor based on evaluating the claims and references in the whole.

Legal motivation is a sophisticated requirement under the stringent requirements of Section 103, and prevents the examiner from fabricating simplistic reasons to combine references for any reason, as the present examiner has done.

The "whole" analysis mandated under Section 103 is another sophisticated requirement which prevents the examiner from selecting naked features from disparate references out of context, as the present examiner has again done.

It is quite clear that Smith expressly illustrates, expressly discloses, and, indeed, expressly recites in claim 1 a linerless label in which two strips of adhesive 34,35 are disposed along the opposite edges and are essential to the performance of the labels.

The examiner has identified nothing in Smith to the contrary.

The examiner has failed to identify any problem in Smith for which any solution in Slagsvol would be relevant.

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Instead, the examiner has merely fabricated a reason, any reason, to combine the disparate references "for the purpose of forming a paper that is easily and rapidly applied to a surface (Column 1, lines 43-44)."

And, what problem is being solved? And, where is that problem disclosed? And, how is that problem relevant to Smith?

That very reference to "Column 1, lines 43-44" merely states in the summary section that: "Tracing paper made in accordance with this invention can be easily and rapidly applied to and removed from an underlying surface."

This is a mere generality, and disregards the express problems not only in Smith, but in Slagsvol, itself.

Slagsvol discloses multiple forms of the tracing paper, including all five figures 1-5 in which the adhesive 2a,b,c,d,e,g,h runs along both edges of the paper, not along a single side.

So would not Slagsvol more appropriately teach two columns of the adhesive corresponding with the two strips of adhesive disclosed in Smith?

Why has the examiner selected only figure 6 of Slagsvol to the exclusion of the other, and greater number of, figures which teach away?

The answer is conspicuous: hindsight selective combination of naked elements without regard to context.

Of what relevance is the "for the purpose" contention presented by the examiner to the different embodiments disclosed in Slagsvol or in Smith?

Legal motivation is not a nebulous concept, but requires evidence and specificity in solving stated specific problems, not fabricated general problems.

"More easily and rapidly applied" the examiner proffers?

Where is the teaching in Smith of any problem therein for which this "solution" of the examiner would be relevant?

The two-strip adhesive labels in Smith appear quite well

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enough efficient at being "easily and rapidly applied," and the examiner has not shown otherwise.

The examiner's problem is contrived for the sole purpose of fabricating the latest rejection, without regard to the stringent requirements under Section 103 and the MPEP.

The obvious feature of the tracing paper for effecting the "rapid and easy" function proffered by the examiner is nothing more than adequate adhesive as expressly disclosed in Slagsvol at col. 2, ll. 26+.

Slagsvol provides no relevant distinction between the dual strips of adhesive shown in figures 1-5 and the single strip shown in figure 6, and, indeed, the Detailed Description in Slagsvol is completely devoid of any reason for the single strip disclosed in figure 6; and the examiner has not shown otherwise.

Accordingly, there is no legal motivation to combine Slagsvol and Smith in any manner, let alone the requisite manners required for the many claims being rejected in toto.

The examiner's "obvious" contention is classic hindsight reconstruction without regard to the express claim language and without regard to the whole of the claims and the two references being applied. It is a mere conclusion divorced from context.

Furthermore, the examiner compounds the errors of rejection in the paragraph at the bottom of page 6. All of the species being addressed by the examiner have been clearly overlooked by the examiner, as based on the mere contention that "the application does not indicate any new, significant attributes"

The specification is replete with benefits attributable to the recited columnar adhesive label including, for example, para 35.

This was previously presented to the examiner in the last office action, and the examiner has failed to answer those benefits as mandated by MPEP 707.07(f), and has conspicuously

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failed to address these species claims individually as required by MPEP 706.02(j).

All species claims recited have due description in the specification, and corresponding benefits overlooked by the examiner in the rush to reject the claims based on disparate references, with, indeed, Slagsvol being nonanalogous both legally under the MPEP and substantively.

Para. 37 introduces the oval patches, and para. 38 presents the particular advantages thereof.

And, the following paragraphs disclose the additional claimed species, and their advantages and benefits, summarized, yet again, at paras. 49 & 50.

The examiner's failure to consider those claims and their features in the whole is an admission undermining any attempt to support the rejection thereof under Section 103.

The examiner's attempt to cite Seid and Dailey from MPEP 2144.04 fails to comply with the basic requirements of case law precedent.

The examiner has failed to establish any factual similarity or nexus for applying these cases.

The examiner's initial need to combine two different references, Smith and Slagsvol, is evidence against the use of these two cases which address the mere change of shape or ornamental features without mechanical function.

The examiner's general statement that "Smith teaches a variety of shapes ..." fails to consider those "shapes" in the whole, or present any basis under Section 103 to reject the specifically recited claims and combinations thereof.

The Col. 3-4 reference by the examiner deals solely with continuous or other patterns having no functional nexus identified by the examiner (See Seid, cited by the examiner).

The Col. 3, ll. 42-46, reference by the examiner applies to the silicone patterns 27,28; and not the continuous adhesive, and are further evidence of examiner error and the failure to

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properly evaluate the claims and references in the whole.

The examiner has failed to show how the "discontinuous strips, dots, a series of polygons, or a wide variety of other patterns" of Smith are in any way relevant to Applicants' claims being rejected, or to the disparate configurations of Slagsvol.

Accordingly, withdrawal of the rejection of claims 1-9, 11-15, 17-25, and 27-29 under Section 103(a) over Smith and Slagsvol is warranted and is requested.

Applicants traverse the rejection of claims 10, 16, and 26 under Section 103(a) over Smith, Slagsvol, and Lane.

As indicated above, Slagsvol is nonanalogous art and is therefore ineffective in supporting the rejection under Section 103.

Claim 10 excludes the index marks, yet Smith expressly requires registration marks 19.

The examiner's use of Lane disregards that the lines of perforations 12 are just as much the equivalent of index marks as the registration marks 19 in Smith, and the examiner has not shown otherwise.

The examiner's bald contention that Lane teaches the absence of index marks is not supported by any evidence therein, and the examiner's reference to "Page 3, Column 1, lines 15-20" has no relevance whatsoever to index marks or the lack thereof, but instead relates solely to the mere spacing of the gummed areas 11.

The examiner yet again offers no "legal motivation" as that requirement is well explained in ch. 2100, but instead fabricates an irrelevant reason, which could be one of many irrelevant reasons, to combine the three disparate references.

Claims 16 & 26 recite the full surface release strip in combination with the columnar adhesive patches completely overlooked by the examiner in the rush to reject.

At the bottom of page 6, the examiner cites Smith at "Column 3, line 60 to Column 4, line 1; Column 3, lines 42-46"

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for some alleged support for the equally irrelevant contention of "Smith discloses the use of discontinuous strips."

How is any of this relevant to claims 16 and 26?

What weight has the examiner afforded to the claim language recited therein?

How possibly could the "discontinuous strips" being proffered by the examiner support the rejection of full surface release strips which are not so discontinuous?

Clearly, the examiner is presenting naked arguments without regard to the accuracy or relevancy thereof, further poisoning the rejections of record.

The column 3-4 reference by the examiner expressly states that the adhesive strips 34,35 are continuous, yet still not full surface coverage; and being adhesive, they are irrelevant to the claim 16,26 recitation for the release strip.

The col. 3, ll. 42-46, reference by the examiner expressly confirm that the silicone patterns 27,28 are continuous strips, and other patterns, but nevertheless are not full surface coverage.

The examiner's combination of Smith, Slagsvol, and Lane is clearly against the very teachings thereof, and is evidence in and of itself of the failure of the examiner to afford any weight, let alone due weight to the combination claims being baldly rejected.

Accordingly, withdrawal of the rejection of claims 10, 16, and 26 under Section 103(a) over Smith, Slagsvol, and Lane is warranted and is requested.

In yet another attempt to terminate the prosecution of this application sooner than later, independent claim 19 is being amended to emphasize the configuration of the label roll for use in the printer so that the individual labels can be cut transversely from the web as described at paras. 21 and 26.

Claim 25 has been amended to recite the index sensor 30 and the configuration of the index marks for detection thereby as

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disclosed at para. 27.

And, independent claim 31 has been amended to recite the imperforate web having the adhesive train cooperating with the release strip therebehind as disclosed at paras. 29,31,36.

The tracing sheet disclosed in Slagsvol is clearly not a label, and is not imperforate due to the express tear lines provided therein; nor does it have the rear release strip.

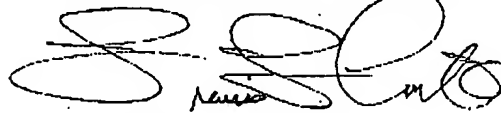
Accordingly, claims 19-29 and 31 are additionally distinguishable over the three applied references.

In accordance with the duty imposed by 37 CFR 1.104 and MPEP sections 707, 707.05, 707.07, and 707.07(g), the examiner is requested to reconsider all the art of record to ensure full compliance with the required thoroughness of examination.

In re Portola Packaging, Inc., 42 USPQ2d 1295 (Fed. Cir. 1997) emphasizes the importance of complying with this duty to ensure that all references of record have been fully considered by the examiner in the various combinations thereof. And, the Board of Appeals has further elaborated on the importance of this examiner duty in Ex parte Schricker, 56 USPQ2d 1723 (B.P.A.I. 2000).

In view of the above remarks, allowance of all claims 1-29 and 31 over the art of record is warranted and is requested.

Respectfully submitted,



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